

REMARKS

The Office Action mailed July 8, 2003 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1 and 3-22 were pending in the application. Claims 1, 5, 20 and 22 have been amended, no claims have been cancelled or newly added. Therefore, claims 1 and 3-22 are submitted for reconsideration by the examiner.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

The Office Action objects to claim 5 for a minor informality. Claim 5 has been amended to address the objection. In addition, the independent claims 1, 20, and 22 have been amended to better define the invention without narrowing the scope of these claims.

In the Office Action, claims 1, 3-17, and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,486,686 to Zdybel et al. (hereafter "Z686"), further in view of U.S. patent 6,400,392 to Yamaguchi et al. (hereafter "Yamaguchi"). Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zdybel '686 and Yamaguchi, further in view of U.S. patent 5,444,779 to Daniele (hereafter "Daniele"). Applicants respectfully traverse these rejections for at least the following reasons.

Each of the independent claims 1, 20, and 22 are directed to an encoding *and* processing method (or system) in which the following sequence of steps is performed: (1) electronic document is created and stored, (2) a mark is placed on a hardcopy corresponding to the stored electronic document including both identification (for purposes of retrieval) and processing information for the electronic document, (3) an image of a hardcopy of captured by an image capture device; (4) the mark is decoded; (5) the electronic document corresponding to the hardcopy is *retrieved* based on the decoded identification information from the mark, and the (6) *retrieved* electronic document is processed in accordance with the processing information from the mark..

The Office Action relies on Z686 for disclosing these claimed features. However, Z686 does not teach or suggest that the electronic document corresponding to the hardcopy be *retrieved* for further processing according to the processing information also stored in the mark placed on the hardcopy of the document. Rather, Z686 is directed to "recovering" the

electronic document 32. In col. 9, lines 45-53, Z686 discloses “[m]ore particularly, if all the digital data contained by the electronic document 32 is printed in digital data form on the hardcopy 102, the electronic document 32 can be recovered merely by employing the input scanner 12 for scanning the glyph encoded data to recover the data that affects the appearance of the document... as well as the data that is not inferable from the appearance of the document....” Therefore, Z686 is concerned with providing information in the mark that is usable to recreate (or recover) the original electronic document. Nowhere does Z686 teach or suggest that the original electronic document should be retrieved per se.

In fact, Z686 is directed at providing encoding information in the hardcopy such that lossless data transmission may be accomplished by using the hardcopy. Therefore, Z686 actually teaches away from the claimed retrieval of the electronic document that is recited in the pending claims. In the Abstract, Z686 states that machine readable domain descriptions of the hardcopy documents are printed on the hardcopy document so that such definitions may be used when the document is transformed from the hardcopy domain to the electronic domain. That is, Z686 teaches that the marks on the hardcopy are used to recreate the original electronic document and not to actually retrieve the original electronic document (for further processing) as recited in the pending claims. In col. 10, lines 23-24, Z686 teaches that the file name and storage information may be stored on the hardcopy presumably to provide additional information for the disclosed transformation from the hardcopy to a electronic form (element 136). See the similarity of use of element 136 with the other elements 131-136 in col. 10, lines 13-27 which are all used to “recover” the electronic document from the hardcopy. See also col. 10, lines 1-5 of Z686.

Therefore, at least this claimed feature in the independent claims 1, 20, and 22 is not disclosed or suggested by Z686. Neither is this deficiency in Z686 cured by any of the other applied references. Accordingly, the pending independent claims are believed to patentable over the applied prior art.

Furthermore, claim 22 recites placing a mark on the hardcopy that is indicative of an annotation or processing instruction based on a received voice input. With respect to this feature the Office Action, cites to col. 6, lines 44-49 of Z686 which only teaches that a voice input annotation may be made for an electronic document processing system. There is no

teaching or suggestion that the voice input annotation or processing instruction be embodied in the mark placed on the hardcopy. Accordingly, this provides another distinction between claim 22 and the applied prior art.

The dependent claims are also allowable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

In view of the foregoing amendments and remarks, applicants believe that the application is in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local number below.

Respectfully submitted,

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By  _____

William T. Ellis
Registration No. 26,874